

Appl. No. 10/671,059
Appeal Brief dated 09/27/2007
Reply to Office Action of 04/27/2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of:	:
Kyle N. Patrick	:
	: Before the Examiner:
Serial No: 10/671,059	: Michael E. Keefer
	:
Filed: 09/25/2003	: Group Art Unit: 2112
	:
Title: METHOD AND COMPUTER	: Confirmation No.: 5839
PRODUCT FOR IDENTIFYING AND	:
SELECTING POTENTIAL E-MAIL	:
REPLY RECIPIENTS FROM A	:
MULTI-PARTY E-MAIL	:

APPELLANTS' BRIEF UNDER 37 C.F.R. §41.37

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal to a final rejection dated April 27, 2007 of the claims in the Application. This brief is submitted pursuant to a Notice of Appeal filed on July 27, 2007 in accordance with 37 C.F.R. §41.31.

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BRIEF FOR APPLICANTS - APPELLANTS

(i)

Real Party in Interest

The real party in interest is International Business Machines Corporation (IBM), the assignee.

(ii)

Related Appeals and Interferences

There are no other appeals or interferences known to appellants, appellants' representative or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(iii)

Status of Claims

Claims 1 – 30 are finally rejected. Claims 6 and 8 – 10 are being appealed.

(iv)

Status of Amendment

An "Amendment after Final" was not filed.

(v)

Summary of Claimed Subject Matter

The invention, as claimed in Claim 1, provides a method of sending an e-mail message to a plurality of users by an e-mail recipient in response to a received e-mail message, the received e-mail message including a chain of

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previously sent e-mail messages wherein each previously sent e-mail message includes at least one previous sender and one previous recipient. The method comprises: parsing the received e-mail message for e-mail addresses of the previous senders and recipients to form a list of e-mail addresses (lines 13 – 14 of the first paragraph on page 4 and lines 4 and 5 of the first paragraph on page 5); displaying said list of e-mail addresses (lines 1 – 5 of the second paragraph on page 4 and lines 5 – 8 of the first paragraph on page 5); selecting, by the e-mail recipient, one or more of the e-mail addresses from the list to address the e-mail message, each selected e-mail address identifying a user to which the e-mail message is to be sent (lines 3 and 4 of the second paragraph on page 4 and lines 8 and 9 of the first paragraph on page 5); and sending the e-mail message to the users identified by the selected addresses (lines 6 and 7 of the second paragraph on page 4 and lines 7 and 8 of the first paragraph on page 5).

(vi)

Grounds of Rejection to be Reviewed on Appeal

Whether it was proper to reject Claim 6 under 35 USC §102(b) as being anticipated by Birrell et al.

Whether it was proper to reject Claims 8 – 10 35 USC §102(e) as being anticipated by Ullmann et al.

(vii)

Arguments

Whether it was proper to reject Claim 6 under 35 USC §102(b) as being anticipated by Birrell et al.

Claim 6 includes the limitations “wherein said received e-mail message is automatically parsed upon receipt of said message. “

Claim 6 also depends directly on Claim 1 which includes the limitations of parsing the received e-mail message for e-mail addresses of the previous senders and recipients to form a list of e-mail addresses; displaying said list of e-mail addresses; selecting, by the e-mail recipient, one or more of the e-mail addresses from the list to address the e-mail message, each selected e-mail address identifying a user to which the e-mail message is to be sent; and sending the e-mail message to the users identified by the selected addresses.

Thus, according to Claim 6 as related to Claim 1, as soon as the e-mail message is received, it is automatically parsed for e-mail addresses of the previous senders and recipients to form a list of e-mail addresses which is displayed to the user.

Birrell et al. purport to teach a technique for dynamically generating an address book in a distributed electronic mail system. Mail messages are stored in message files of a mail service system. The mail messages are parsed and indexed to generate a full-text index of the mail service system. Address book mail messages are generated, each address book mail message includes address information. The address information can be generated using a form supplied by client mail application programs executing on the particular client computer. The address book mail messages are stored in the message files. The address book mail messages are also parsed and indexed into the full-text index file. When a user wants an address, the user composes a query to search the full-text index to locate and retrieve selected ones of the address book mail messages as the dynamic address book. The client mail application programs are down-loaded to the particular client computer via the network.

Thus, Birrell et al. teach the step of searching for particular messages from stored messages using keywords. Once the stored messages are found, then a dynamic address book (i.e., an address book that contains the address information of the particular e-mail messages) will be displayed to the user. The user may then select e-mail addresses from the dynamic address book. However, nowhere in the disclosure of Birrell et al. is there a teaching of retrieving chained e-mail addresses.

Hence, Birrell et al. do not teach the step of parsing an e-mail message for e-mail addresses of previous senders and recipients as soon as the e-mail message is received as in Claim 6.

It is a well settled law that in considering a Section 102 rejection, all the elements of the claimed invention must be disclosed in a single item of prior art in the form literally defined in the claim. *Jamesbury Corp. v. Litton Indus. Products*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985); *Atlas Powder Co. v. Dupont*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *American Hospital Supply v. Travenol Labs.*, 745 F.2d 1, 223 USPQ 577 (Fed. Cir. 1984).

Since Birrell et al. do not teach the claimed invention in the form literally defined in Claim 6, Appellants submit that Birrell et al. do not anticipate Claim 6.

Whether it was proper to reject Claims 8 – 10 35 USC §102(e) as being anticipated by Ullmann et al.

Claim 8

Claim 8 depends directly on Claim 1 and includes the limitations “wherein prior to said parsing step a list of potential reply e-mail addresses is requested.”

Therefore, before a received e-mail message is parsed for e-mail addresses of the previous senders and recipients, a list of potential reply e-mail addresses is requested.

Ullmann et al. teach an enhanced e-mail reader and composer having automatic addressing functions to create and manage chain groups for organizing chain-forwarded and chain-replied messages. The e-mail reader and composer allow users to receive chained messages. The addresses of the chain messages (or the chained addresses) are entered into an address book cross-referenced to a chain key. The chain key is used to access the chained addresses from the address book. When the user is replying to an e-mail, for example, the previous e-mail message (i.e., the message the user is replying to) is parsed for the chain key. If the chain key is not found in the previous e-mail message, the user is allowed to come up with a chain key for the e-mail message, associate the chain key in the address book with e-mail addresses. If the chain key is found in the previous e-mail message, then the address book is parsed for the chain key also. If the chain key is found in the address book then the e-mail addresses associated with the chain key in the address book are displayed. If the chain key is not found in the address book, the user is allowed to associate the chain key with addresses in the address book. Then the addresses are displayed to the user.

However, Ullmann et al. do not teach the step of ***requesting a list of potential reply e-mail addresses prior to parsing for e-mail addresses of the previous senders and recipients*** as in Claim 8.

Claim 9

Claim 9 includes the limitations “wherein said response is formed by auto-populating SMTP headers with said list of e-mail addresses.”

As in the case of Claim 8, Claim 9 depends directly on Claim 1, which reads: a method of sending an e-mail message to a plurality of users by an e-mail recipient in response to a received e-mail message, the received e-mail message including a chain of previously sent e-mail messages wherein each previously sent e-mail message includes at least one previous sender and one previous recipient, the method comprising: parsing the received e-mail message for e-mail addresses of the previous senders and recipients to form a list of e-mail addresses; displaying said list of e-mail addresses; selecting, by the e-mail recipient, one or more of the e-mail addresses from the list to address the e-mail message, each selected e-mail address identifying a user to which the e-mail message is to be sent; and sending the e-mail message to the users identified by the selected addresses.

Consequently, the response of the received e-mail is formed by auto-populating SMTP headers with the list of e-mail addresses.

Ullmann et al. does not teach auto-populating headers with the list of e-mail addresses. Instead, Ullmann et al teach searching and finding a chain key in both a message and a contact book; if successful, then email address are displayed to the user for user-selection.

Hence, Ullmann et al. do not anticipate Claim 9.

Claim 10

Claim 10 depends directly on claim 1 and includes the limitations “wherein said response is formed by auto-populating user interface graphical elements.”

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As mentioned above in respect to Claim 9, Ullmann et al. teach searching and finding a chain key in both a message and a contact book; if successful, then email address are displayed to the user for user-selection.

However, Ullmann et al. do not teach auto-populating user interface graphical elements as in Claim 10. Hence Applicants submit that Ullmann et al. do not anticipate Claim 10.

Based on the foregoing, Appellants request reversal of the rejection to Claims 6, 8 - 10.

Respectfully Submitted

By: 

Volel Emile
Attorney for Applicants
Registration No. 39,969
(512) 306-7969

(viii)

Claims Appendix

1. (Previously presented) A method of sending an e-mail message to a plurality of users by an e-mail recipient in response to a received e-mail message, the received e-mail message including a chain of previously sent e-mail messages wherein each previously sent e-mail message includes at least one previous sender and one previous recipient, the method comprising:

parsing the received e-mail message for e-mail addresses of the previous senders and recipients to form a list of e-mail addresses;

displaying said list of e-mail addresses;

selecting, by the e-mail recipient, one or more of the e-mail addresses from the list to address the e-mail message, each selected e-mail address identifying a user to which the e-mail message is to be sent; and

sending the e-mail message to the users identified by the selected addresses.

2. (Original) The method of claim 1 wherein said received e-mail message is a multi-party e-mail.

3. (Previously presented) The method of claim 1 wherein said list of parsed e-mail addresses is displayed in response to an action by the e-mail recipient.
4. (Previously presented) The method of claim 3 wherein said action comprises initiating a reply message.
5. (Previously presented) The method of claim 1 wherein said received e-mail message is automatically parsed prior to said action.
6. (Previously presented) The method of claim 1 wherein said received e-mail message is automatically parsed upon receipt of said message.
7. (Previously presented) The method of claim 1 wherein said received e-mail message is displayed prior to being parsed.
8. (Previously presented) The method of claim 1 wherein prior to said parsing step a list of potential reply e-mail addresses is requested.
9. (Previously presented) The method of claim 1 wherein said response is formed by auto-populating SMTP headers with said list of e-mail addresses.
10. (Previously presented) The method of claim 1 wherein said response is formed by auto-populating user interface graphical elements.

11. (Previously presented) A computer program product for sending an e-mail message to a plurality of users by an e-mail recipient in response to a received e-mail message, the received e-mail message including a chain of previously sent e-mail messages wherein each previously sent e-mail message includes at least one previous sender and one previous recipient, said computer program product comprising:

a computer usable medium having computer readable program code means embodied in said medium for:

parsing the received e-mail message for e-mail addresses of the previous senders and recipients to form a list of e-mail addresses;

displaying said list of e-mail addresses;

selecting, by the e-mail recipient, one or more of the e-mail addresses from the list to address the e-mail message, each selected e-mail address identifying a user to which the e-mail message is to be sent; and

sending the e-mail message to the users identified by the selected addresses.

12. (Original) The computer program product of claim 11 wherein said received e-mail message is a multi-party e-mail.

13. (Previously presented) The computer program product of claim 11 wherein said list of parsed e-mail addresses is displayed in response to an action by the e-mail recipient.
14. (Previously presented) The computer program product of claim 13 wherein said action comprises initiating a reply message.
15. (Previously presented) The computer program product of claim 11 wherein said received e-mail message is automatically parsed prior to said action.
16. (Previously presented) The computer program product of claim 11 wherein said received e-mail message is automatically parsed upon receipt of said message.
17. (Previously presented) The computer program product of claim 11 wherein said received e-mail message is displayed prior to being parsed.
18. (Previously presented) The computer program product of claim 11 wherein prior to said parsing step a list of potential reply e-mail addresses is requested.
19. (Previously presented) The computer program product of claim 11 wherein said response is formed by auto-populating SMTP headers with said list of e-mail addresses.

20. (Previously presented) The computer program product of claim 11 wherein said response is formed by auto-populating user interface graphical elements.

21. (Previously presented) An article comprising:

a computer readable modulated carrier signal;

means embedded in said signal for sending an e-mail message to a plurality of users by an e-mail recipient in response to a received e-mail message, the received e-mail message including a chain of previously sent e-mail messages wherein each previously sent e-mail message includes at least one previous sender and one previous recipient, by

parsing the received e-mail message for e-mail addresses of the previous senders and recipients to form a list of e-mail addresses;

displaying said list of e-mail addresses;

selecting, by the e-mail recipient, one or more of the e-mail addresses from the list to address the e-mail message, each selected e-mail address identifying a user to which the e-mail message is to be sent; and

sending the e-mail message to the users identified by the selected addresses.

22. (Original) The article of claim 21 wherein said received e-mail message is a multi-party e-mail.
23. (Previously presented) The article of claim 21 wherein said list of parsed e-mail addresses is displayed in response to an action by the e-mail recipient.
24. (Previously presented) The article of claim 23 wherein said action comprises initiating a reply message.
25. (Previously presented) The article of claim 21 wherein said received e-mail message is automatically parsed prior to said action.
26. (Previously presented) The article of claim 21 wherein said received e-mail message is automatically parsed upon receipt of said message.
27. (Previously presented) The article of claim 21 wherein said received e-mail message is displayed prior to being parsed.
28. (Previously presented) The article of claim 21 wherein prior to said parsing step a list of potential reply e-mail addresses is requested.
29. (Previously presented) The article of claim 21 wherein said response-is formed by auto-populating SMTP headers with said list of e-mail addresses.

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30. (Previously presented) The article of claim 21 wherein said response is formed by auto-populating user interface graphical elements.

(ix)

Evidence Appendix

None.

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(x)

Related Proceedings Appendix

None.